

REMARKS

This communication responds to the Final Office Action having an electronic notification date of May 28, 2009. Claims 1 and 15 are amended, and no claims have been added or canceled. As a result, claims 1-28 remain pending in this application.

Support for amendments to claim 1 can be found, for example, in paragraphs [0030] and [0047] of Applicants' published application.¹ Support for amendments to claim 15 can be found, for example, in paragraph [0047] of Applicants' published application.

§ 101 Rejection of the Claims

Claims 1-14 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action stated that claim 1 is not tied to a particular machine nor does it transform underlying subject matter to a different state or thing as required by *In re Bilski*, 88 USPQ 2d 1385 (Fed. Cir. 2008).

Independent claim 1 is amended to recite, in part, "*defining instructions, at a computer, to implement the change to the product structure*" and "*automatically implementing the change, at the computer. . .*" In determining whether a claimed method constitutes a statutory "process" under §101, the proper standard is the machine-or-transformation test.² The machine-or-transformation test is a two-prong inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms underlying subject matter.³ Certain considerations are applicable to either prong. First, the use of a specific machine or transformation of underlying subject matter must impose meaningful limits on the claim's scope.⁴ Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.⁵

Claim 1 satisfies the machine prong by reciting, at least, "*defining instructions, at a computer, to implement the change to the product structure*" and "*automatically implementing*

¹ U.S. 2005/0022156

² *In re Bilski*

³ *Id.*

⁴ *Id.*

⁵ *Id.*

*the change, at the computer. . .*⁶ The operations of claim 1 are tied to a specific machine (“a computer”). Furthermore, the cited limitations impose meaningful limits on the claim’s scope, because these operations must involve the specific machine and no other machine. Moreover, involvement of the machine is not insignificant extra-solution activity, because the machine performs the operations of the claim. Thus, the machine prong of the machine-or-transformation test is satisfied. Applicants further assert that independent claim 1 is statutory in that, since it is specifically tied to a computer, the use of the computer is considered as, “A particular practical application of a judicial exception [that] is eligible.”⁷

For at least these reasons, claim 1 and its dependent claims 2-14 are directed to statutory subject matter. Thus, Applicants respectfully request that these rejections under 35 U.S.C. § 101 be reconsidered and withdrawn.

§ 102 Rejection of the Claims

Claims 1-28 were rejected under 35 U.S.C. § 102(c) as being anticipated by Matheson (U.S. 6,944,514). Applicants have amended independent claims 1 and 15 to further clarify distinctions over Matheson. Specifically, claim 1 has been amended to recite, in relevant part:

[A]ssociating a first validity for the change with a first organizational structure, the first organizational structure having a first organizational view of the product structure, *the first validity determining if the change is allowed by the first organizational structure and when the instructions to implement the change affect the product structure*; [and]

associating a second validity for the change with a second organizational structure, the second organizational structure having a second organizational view of the product structure, *the second validity determining if the change is allowed by the second organizational structure and when the instructions to implement the change affect the product structure*[.]

⁶ Claim 1, emphasis added.

⁷ See *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101* (August 25, 2009) at 15.

In order to anticipate a claim, a reference must disclose all limitations, arranged or combined in the same way as recited in Applicants' claim. The Court of Appeals for the Federal Circuit recently held:

[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102. *Net MoneyIn, Inc. v. Verisign, Inc.*, No. 2007-1565 at 17 (Fed. Cir. Oct. 20, 2008). (Emphasis added)⁸

The current Final Office Action stated in the *Response to Arguments* section,⁹ that “[a]s a result, Matheson indeed discloses an enhancement or improvement to an existing product (i.e., change, column 5, lines 21-25) that has to fulfill a plurality of requirements (i.e., validity) from various organization structures (i.e., marketing, customers, engineering, manufacturing).”¹⁰ However, neither these particular citations from *Matheson*, nor any other of the citations which the Examiner relied upon, disclose “*the first validity determining if the change is allowed by the first organizational structure and when the instructions to implement the change affect the product structure*” and “*the second validity determining if the change is allowed by the second organizational structure and when the instructions to implement the change affect the product structure*” as recited in amended claim 1.

In contrast to Applicants' claim, *Matheson* describes a Product Idea, which “may be an idea for a new product, an enhancement or improvement to an existing product, or the solution to a known problem (such as an Engineering Change) for an existing product”¹¹ and a Product Requirement, which “encapsulates a requirement that the product must or should or could fulfill.”¹² These ideas and requirements are therefore tied to features of the products and are not tied to whether a potential change to the product is allowed by the organizational structures or when the change will affect the product structure. Whether the potential change is valid and when it will be valid is not a requirement that the product must or should or could fulfill because

⁸ See also *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))

⁹ Final Office Action at 7 *et seq.*

¹⁰ Final Office Action mailed 5/28/09, pp. 8-9

¹¹ *Matheson*, column 5, lines 22-25

¹² *Matheson*, column 5, lines 26-27

Matheson is describing features of the products themselves. Thus, *Matheson* merely discusses an enhancement or improvement to an existing product that has to fulfill a plurality of requirements, such as design or regulatory constraints on the product. However, *Matheson* does not disclose, *inter alia*, “the first validity determining if the change is allowed by the first organizational structure and when the instructions to implement the change affect the product structure,” “the second validity determining if the change is allowed by the second organizational structure and when the instructions to implement the change affect the product structure,” or “automatically implementing the change according to the first validity for the first organizational view, and according to the second validity for the second organizational view,” as recited in the limitations of amended claim 1.

Because *Matheson* fails to disclose all limitations of Applicants’ independent claim 1, this claim is not anticipated, and is thus novel. Further, since claims 2-14 depend, either directly or indirectly from claim 1, they too are allowable for at least the same reasons. Further, claims 2-14 each may contain additional patentable subject matter.

Moreover, independent claim 15 has been amended similarly to independent claim 1, and its dependent claims 16-28 recite similar limitations as the subject matter of claims 2-14. Therefore, claims 15-28 are allowable for at least the same reasons as argued above for claim 1. Further, claims 15-28 each may contain additional patentable subject matter.

Since Applicants have shown that not all the claimed limitations were known as required by *Net MoneyIn*, Applicants respectfully request the Examiner reconsider and withdraw the rejection under 35 U.S.C. §102(e) with regard to claims 1-28.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of September, 2009.

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Signature